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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,605	09/15/2003	Mickey Roemer	83336.0634	2363
66880 7590 02/12/2007 STEPTOE & JOHNSON, LLP 1330 CONNECTICUT AVENUE, NW WASHINGTON, DC 20036			EXAMINER PIERCE, WILLIAM M	
			ART UNIT	PAPER NUMBER
			3711	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/12/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/662,605

Applicant(s)

ROEMER ET AL.

Examiner

William M. Pierce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/22/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-97 is/are pending in the application.
- 4a) Of the above claim(s) 62-97 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.


Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


WILLIAM M. PIERCE
PRIMARY EXAMINER

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claim 60 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

See explanation below in response to applicants remarks.

Claim Rejections - 35 USC § 103

Claims 1- 59 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Monte Carlo in view of Kelly 5,882,258 as set forth in the previous office action and further in view of Same Game as set forth in the previous office action;

Claim 1 has now been amended to include a pair "and three or more adjacent game pieces". A popular electronic version of Monte Carlo is Same Game or Jawbreaker. In this game a player can select two or more pieces. To have allowed a persons to select three adjacent pieces in Monte Carlo would have been obvious in order to allow a player to remove more pieces during each turn.

With respect to claims 31 and 61, in Monte Carlo the cards are moved up to fill the spaces of the removed cards and not replaced as stated by applicant. This is considered to meet the limitations of "shuffling" as called for in the claims.

As to claim 60, the specification merely states that "deactivation...does not necessarily result in the removal" but is most certainly could. The plain meaning of deactivate is to make inactive or ineffective. As such the examiners interpretation that removing cards as shown by Monte Carlo meets this limitation by now making the cards inactive is considered fair.

Applicant's arguments filed 11/22/06 have been fully considered but they are not persuasive.

The initial issue presented in applicant's remarks pertains to the interpretation of "shuffling". From pg. 5 of applicant's specification, shuffling "further includes shuffling any non-selected game pieces remaining within the game grid into a consolidated grouping, after all matching adjacent game pieces that have been perceived by a 15 player have been selected and removed". Clearly the steps of moving the pieces in Monte Carlo and Jawbreaker to down to fill in the spaces of any removed cards meet the steps of "shuffling" or rearranging the cards. On pg. 12 of the specification, "the shuffling process consolidates the remaining game pieces into a consolidated, contiguous arrangement that creates new adjacent game piece positions." Clearly Monte Carlo and Jawbreaker again meet this definition of "shuffling" as set forth in the specification. Nothing in the specification supports applicants assertion that shuffling is an "act of mixing cards haphazardly" (bottom pg. 10 of remarks).

With respect to claim 60, the specification precisely recites, "In such an embodiment, the deactivation of the matching adjacent game pieces that are selected does not necessarily result in the removal of those game pieces from the gaming grid. In this way, for example, the game pieces may be used in subsequent games upon reshuffling

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of the game pieces." Here it is only broadly suggestion the such may or may "not necessarily" occur. Such is not considered to be adequate support for the limitations now specifically called for in the claims. The mere fact that a certain thing may result from a given set of circumstances is not sufficient to show adequate support." In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Adequate support can only be shown by explicit discussion of that embodiment in the specification and not from a broad suggestion in the specification.


Conclusion

Applicant's arguments filed 11/22/06 have been fully considered but they are not persuasive as set forth in the above grounds for rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Pierce whose telephone number is 571-272-4414 and E-mail address is bill.pierce@USPTO.gov. The examiner can normally be reached on Monday and Friday 9:00 to 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


WILLIAM M. PIERCE
PRIMARY EXAMINER